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EXAMINER	
PESELEV, E	

  

ART UNIT	PAPER NUMBER
183	7

DATE MAILED: 07/23/90

PETER C. RICHARDSON  
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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 4-26-90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-692.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-40 are pending in the application.  
Of the above, claims 36-39 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-35 and 40 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

EXAMINER'S ACTION

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Claims 36-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a nonelected invention, the requirement having been traversed in Paper No. 5.

Claims 1-35 and 40 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-5 and 7-9 of United States Patent No. 249,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds are encompassed by the compounds of the copending application S.N. 249,749.

The obviousness type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Applicant's arguments filed April 26, 1990 have been fully considered but they are not deemed to be persuasive.

Applicants contend that the claimed compounds have an alpha-branched group attached at the C-25 position, while the compounds of the copending application do not. However, same argument has not been found persuasive since compounds of the copending application read broadly on alkyl, alkenyl, etc. and therefore encompass alpha-branched groups.

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Claims 1-3, 17, 28, 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 encompasses compounds wherein R<sup>2</sup> is an alpha-branched alkyl having 3 or 4 carbon atoms, but excludes compounds wherein R<sup>2</sup> is isopropyl or sec-butyl. However, an alpha-branched alkyl having 3 carbon atoms can only be isopropyl and an alpha-branched alkyl having 4 carbon atoms can only be sec-butyl.

Therefore, claim 1 is inconsistent in its terminology.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 1-3, 17, 28, 33-35 and 40 are rejected under 35 U.S.C. 103 as being unpatentable over Mrozik '209.

Mrozik discloses avermectin and milbemycin anti-parasitic agents having iso-propyl or sec-butyl group at the 25 position but does not disclose avermectin and milbemycin compounds containing alpha-branched alkyl group having 5 carbon atoms at the 25-position. Since alpha-branched group having 5 carbon atoms is a next higher homologue of a sec-butyl group, it would have been obvious to a person having ordinary skill in the art at the time of the instant invention to substitute alpha-branched alkyl group having 5-carbon atoms for the sec-butyl group on the compounds disclosed by Mrozik. The instant compounds, compositions and method are deemed obvious over Mrozik.

Applicant's arguments filed April 26, 1990 have been fully considered but they are not deemed to be persuasive.

The compounds of the instant invention are still seen to differ from the reference's compound only at the 25 position. Since, as discussed above, the group

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encompassed by the instant claims is a next higher homologue of the group disclosed by the reference's, the instant compounds are still seen to be obvious variants therefrom.

Claims 1-3, 17, 28, 33-35 and 40 are rejected under 35 U.S.C. 103 as being unpatentable over British patent '436 in combination with Mrozik '209.

The British patent '436 discloses milbemycin derivatives having hydrogen at the 13-position and an alkenyl group at the 25-position and a composition containing the same possessing antibiotic activity but does not disclose milbemycin derivatives having a sugar moiety at the 13-position. Since Mrozik discloses interchangeability of hydrogen and a sugar moiety at the 13-position of a closely analogous milbemycin derivative, it would have been obvious to a person having ordinary skill in the art at the time of the instant invention to substitute a sugar moiety for a hydrogen at the 13-position of milbemycin derivative disclosed by the British patent '436 with an expected result. The instant compounds, composition and methods are deemed obvious over the British patent in combination with Mrozik.

Applicant's arguments filed April 26, 1990 have been fully considered but they are not deemed to be persuasive.

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The Mrozik patent clearly teaches that the group at the 13-position of a closely analogous compound can be hydrogen or 4'-( $\alpha$ -L-oleandrosyl)- $\alpha$ -L-oleandrose group. Therefore, to substitute 4'-( $\alpha$ -L-oleanodrosyl)- $\alpha$ -L-oleandrose group for the hydrogent at the 13-position of a compound disclosed by the European patent would have been obvious to a person having ordinary skill in the art at the time of the instant invention. Also, note that even though Mrozik and the British patent do not disclose a process for preparing a claimed product, it is presumed that skilled workers in the art would as matter of course make certain experiments and adaptations, within the skill of the competent worker and be able to modify the known compounds disclosed by the art of record in order to prepare the claimed compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (703) 557-2704.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 557-0664.

CP  
PESELEV:ew

07-12-90

retyped 07-13-90

*Elli Peselev*  
ELLI PESELEV  
PATENT EXAMINER  
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